

Customer No. 24498
Attorney Docket No. RCA89520
Examiner's Answer Dated: 8/4/2009

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**Appellants: CHEAH, Sin Hui, et al.****Ser. No.: 10/030,766****Filed: October 22, 2001****For: MULTI-FORMAT PERSONAL DIGITAL AUDIO PLAYER****Examiner: SELLERS, Daniel R.****Art Unit: 2614**

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REPLY BRIEF

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Sir:

In response to the Examiner's Answer dated August 4, 2009, Appellants hereby submit a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being faxed to the United States Patent & Trademark Office, fax # 571-273-8300, Mail Stop: Appeal Brief-Patents on:

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Fideliz Romero
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Response to Examiner's Answer

In response to the Examiner's Answer dated August 4, 2009, Appellants maintain that claims 1-7 and 9-10 are patentable under 35 U.S.C. §112, first and second paragraphs, and also patentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,425,018 issued to Kaganas et al. (hereinafter, "Kaganas") in view of U.S. Patent No. 7,324,974 issued to Cho et al. (hereinafter, "Cho"), and further in view of U.S. Patent No. 6,173,057 issued to Truong et al. (hereinafter, "Truong").

A. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §112, First Paragraph

In the Examiner's Answer dated August 4, 2009, the Examiner newly asserts on page 8 that claims 1-7 and 9-10 fail to satisfy the "enablement" requirement of 35 U.S.C. §112, first paragraph. Prior to the Examiner's Answer (e.g., see the final Office Action dated October 31, 2008), the Examiner has asserted that claims 1-7 and 9-10 fail to satisfy the "written description" requirement of 35 U.S.C. §112, first paragraph.

As pointed out in Appellants' previously submitted appeal brief, claims 1-7 and 9-10 clearly satisfy the "written description" requirement of 35 U.S.C. §112, first paragraph. As such, Appellants maintain those arguments as presented in the appeal brief, and hereby incorporate the same by reference herein in their entirety.

Moreover, with respect to the Examiner's newly asserted argument, Appellants submit that claims 1-7 and 9-10 also clearly satisfy the "enablement" requirement of 35 U.S.C. §112, first paragraph. In particular, the "enablement" requirement of 35 U.S.C. §112, first paragraph focuses on whether the specification describes the claimed invention in sufficient detail so as to enable one skilled in the relevant art to make and use the same without undue experimentation. The "enablement" requirement of 35 U.S.C. §112, first paragraph is a separate and independent requirement, and may be contrasted with the "written description" requirement of the same paragraph which focuses on whether the claimed invention is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

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The claim language in dispute is recited in claim 1, for example, as follows: "using a security code associated with the handheld audio playback device to **generate** a decryption program" (emphasis added). In the Examiner's Answer dated August 4, 2009, the Examiner specifically asserts that the "generating" function of the foregoing step is not enabled by Appellants' specification.

Appellants respectfully disagree. In particular, and as acknowledged previously by the Examiner, Appellants' specification clearly states that "DSP 12 decrypts the decryption program using the security code" (emphasis added – see page 7, lines 24-25). In view of this description, it should be intuitive to those skilled in the art that the "generating" function is performed by decrypting the decryption program. That is, using the "security code" to decrypt the decryption program inherently generates a [decrypted] "decryption program". Accordingly, Appellants submit that the "generating" function is in fact described by the specification in sufficient detail so as to enable one skilled in the relevant art to make and use the invention without undue experimentation, and respectfully request the Board to reverse this rejection.

B. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §112, Second Paragraph

Appellants submit that the current claim language is sufficiently clear and definite for the reasons presented in their appeal brief, and respectfully request the Board to reverse this rejection.

C. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §103(a)

On page 11 of the Examiner's Answer dated August 4, 2009, the Examiner continues to admit that neither Kaganas nor Cho discloses the feature of "using a security code associated with the handheld audio playback device to generate a decryption program" as recited, for example, by claim 1.

Previously, in the final Office Action dated October 31, 2008, the Examiner alleged that Truong remedied the foregoing deficiency of Kaganas and Cho (specifically citing column 3, lines 25-26 and lines 34-36, and column 4, lines 24-58 of Truong). However, later, in Appellants' appeal brief, it was pointed out that Truong, in fact, fails

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to remedy this deficiency of Kaganas and Cho. In response to the appeal brief, the Examiner (while still citing column 3, lines 10-26 of Truong) now, on page 11 of the Examiner's Answer dated August 4, 2009, alleges:

"Cho teaches a security code, or key, associated with the audio playback device to decrypt an audio file, and it is the combination that makes obvious the use of a security code associated with the handheld audio playback device to be used to decrypt associated applications."

In response, it appears that the Examiner is now attempting to remedy the aforementioned admitted deficiency of Kaganas and Cho not by relying on Truong (as previously argued), but rather by relying on Cho. As such, Appellants submit that there appears to be some ambiguity regarding exactly what teachings of what references the Examiner is relying on for the instant rejection. The ostensible shift in the Examiner's position in the Examiner's Answer suggests that the instant rejection is simply the product of impermissible hindsight reconstruction based on teachings gleaned from the Appellants' disclosure, and from improperly filling-in the missing gaps of the prior art in an attempt to meet the elements of the claimed invention.

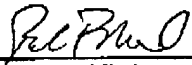
In any event, Appellants submit that none of the cited references, whether taken individually or in combination, discloses or suggests the desirability of the unique combination of features defined by independent claims 1, 4, 6 and 10 wherein a security code associated with a handheld audio playback device is used to generate a decryption program that is then used to decrypt both a selected audio data file and a decoder file associated with the selected audio data file (i.e., see, for example, claim 1 – "using a security code associated with the handheld audio playback device to generate a decryption program; decrypting the associated decoder file using the decryption program; decrypting the selected audio data file using the decryption program").

Accordingly, Appellants submit that claims 1-7 and 9-10 are patentably distinguishable over the cited combination of references under 35 U.S.C. §103(a), and

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respectfully request that the Board reverse this rejection and pass this application to issue.

Respectfully submitted,

By: 
Paul P. Kiel
Reg. No. 40,677
Phone (609) 734-6815

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, New Jersey 08540
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